

## **ADMINISTRATIVE PANEL DECISION**

Truckers Choice Services, Inc. v. Brad Klepper, Drivers Legal Plan, Ltd.  
Case No. D2023-1117

### **1. The Parties**

The Complainant is Truckers Choice Services, Inc., United States of America (“United States”), represented by Dunlap Coddling, P.C., United States.

The Respondent is Brad Klepper, Drivers Legal Plan, Ltd., United States, represented by McAfee & Taft, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <roadlaw.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 14, 2023. On March 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 15, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Drivers Legal Plan, Ltd.) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 16, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on March 16, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 9, 2023. Upon the Respondent’s request, the Center extended the due date for Response until April 13, 2023. The Response was filed with the Center April 13, 2023. On April 22, 2023, the Complainant submitted a supplemental filing. On April 28, 2023, the Respondent submitted a supplemental filing.

The Center appointed Evan D. Brown, W. Scott Blackmer, and Brian J. Winterfeldt as panelists in this matter on May 9, 2023. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

On June 12, 2023, the Panel issued an Administrative Panel Procedural Order (“Procedural Order”), inviting the Complainant to submit evidence and any additional argument concerning the following assertions in the Complaint:

“Respondent’s bad faith registration and use of the Disputed Domain Name is further evidenced by the fact that Respondent was fully aware Complainant operates under the name, ROAD LAW because Complainant’s founders were employed by an entity which was affiliated with the Respondent before they left to create Truckers Choice Services, LLC in 1998. Truckers Choice Services, LLC merged to Truckers Choice Services, Inc. in 2000. The owners of the affiliated entity were aware of Complainant’s company when they left and had adequate knowledge of the ROAD LAW mark as early as the late 1990s.”

The Procedural Order also stated that the Panel would be interested in seeing evidence that corroborates the assertions that “Respondent was fully aware Complainant operates under the name, ROAD LAW” as asserted in the Complaint.

The Procedural Order provided a deadline of June 17, 2023 for the Complainant to provide such additional evidence and argument and a deadline of June 22, 2023 for the Respondent to respond to the submission. The Complainant provided an additional submission on June 16, 2023. The Respondent provided an additional submission on June 22, 2023.

#### **4. Factual Background**

The Complainant is in the business of providing legal services to commercial truck drivers accused of violating traffic laws. It owns the trademark ROAD LAW which it has registered in the United States (Reg. No. 2,340,265, registered on April 11, 2000). The Complainant asserts—both in the Complaint and in submissions to the United States Patent and Trademark Office (“USPTO”)—that it has used the ROAD LAW mark in commerce since at least as early as June 1, 1998.

The Respondent is a law firm “dedicated to protecting the rights of truck drivers, and therefore the interests of trucking companies”. The disputed domain name was registered on September 11, 2002. The disputed domain name redirects Internet users to the Respondent’s website found at <driverslegalplan.com>.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant’s trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

##### **B. Respondent**

The Respondent generally disputes the Complainant’s contentions. As for the first element under the Policy, the Respondent asserts that the Complainant’s use of the ROAD LAW mark is not a trademark use, but instead is a mere description of the types of services that the Complainant provides. Under the second element, the Respondent asserts that it registered and used the disputed domain name because of its highly descriptive properties, and that it did not target the Complainant, shown by the fact that the Respondent registered and used other domain names purportedly descriptive of the services that the Respondent

provides. And as for the third element, the Respondent similarly asserts there was no bad faith registration and use because it chose the domain solely for its descriptive value.

The Respondent asks the Panel to find that the Complainant engaged in Reverse Domain Name Hijacking.

The Respondent also asks that the Panel consider the equitable doctrine of laches, pointing out that (1) the disputed domain name was registered more than 20 years prior to these proceedings, (2) the Respondent has no knowledge of any actual consumer confusion arising out of the use of the disputed domain name, (3) the Complainant never reached out to the Respondent concerning the disputed domain name prior to these proceedings, which tends to show that any business disruption or confusion is either non-existent or minimal, otherwise the Complainant would have reached out earlier. The Respondent asserts that laches in and of itself would be an appropriate basis to deny the Complaint altogether. But if the Panel declines to apply laches to deny the Complaint, according to the Respondent, laches should at least be applied to erode or undermine the Complainant's arguments concerning the second and third elements under the Policy.

## 6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and (iii) the disputed domain name has been registered and is being used in bad faith. The Panel finds that all three of these elements have been met in this case.

### A. Identical or Confusingly Similar

This first element under the Policy functions in effect as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the ROAD LAW mark by providing evidence of its trademark registrations.

The disputed domain name incorporates the ROAD LAW mark in its entirety. This is sufficient for showing confusing similarity. Accordingly, the Complainant has established this first element under the Policy.

### B. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainant). See [WIPO Overview 3.0](#), section 2.1; *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

On this point, the Complainant asserts that: (1) the Respondent is not a licensee of the Complainant nor is the Respondent otherwise authorized to use the ROAD LAW mark for any purpose, (2) the Respondent is not commonly known by the disputed domain name, (3) "upon information and belief," the Respondent is not commonly known by the disputed domain name, and (4) the Respondent is not using the disputed domain name with a *bona fide* offering of goods and services, but instead is using the disputed domain name to redirect Internet users to its own website offering identical services for commercial gain.

The Panel has undertaken limited factual research into matters of public record that it considers useful to assessing the case merits and reaching a decision, which is appropriate in accordance with section 4.8 of the [WIPO Overview 3.0](#) and the general powers of a panel articulated in paragraphs 10 and 12 of the Rules. As a result of this research, the Panel notes that the Complainant has used the mark ROAD LAW on its website consistently over the past 22 years (since at least as early as 2001).

The Panel finds that the Complainant has established, *prima facie*, that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Panel acknowledges the Respondent's argument that the disputed domain name is highly descriptive, incorporating the term "road law," and that this thereby affects the Respondent's asserted rights and legitimate interests in the disputed domain name. The parties dispute whether "road law" is a commonly used term in the Respondent's line of business. But the Panel need not delve too deeply into the issue. The Complainant has provided evidence—apparently uncontroverted—of its longstanding use and registration of the ROAD LAW trademark. Even if the Panel were to find that the ROAD LAW mark is descriptive, the more than 20 years of use, and the registration of the mark, would have caused the mark to have acquired distinctiveness in the marketplace. Despite the Respondent's claims of deriving value from the use of the disputed domain name, any rights arising from such use does not alter—let alone prevail over—the rights that the Complainant has in the ROAD LAW mark due to the Complainant's over 20 years of consistent and uninterrupted use.

The Respondent argues that laches should guide the Panel in denying the Complaint, either causing the Panel to find in the Respondent's favor on that basis alone, or at least finding that laches has eroded or undermined the Complainant's arguments with respect to the Respondent's rights or legitimate interests.

[WIPO Overview 3.0](#), section 4.17 is particularly instructive in addressing the Respondent's assertions on this point:

"Panels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits.

Panels have noted that the UDRP remedy is injunctive rather than compensatory, and that a principal concern is to halt ongoing or avoid future abuse/damage, not to provide equitable relief. [...] Panels have therefore declined to specifically adopt concepts such as laches or its equivalent in UDRP cases.

Panels have however noted that in specific cases, certain delays in filing a UDRP complaint may make it more difficult for a complainant to establish its case on the merits, particularly where the respondent can show detrimental reliance on the delay."

The Panel reiterates that the UDRP does not contain a specific limitation period, and there is a consensus view that delay in bringing a complaint does not of itself prevent a Complainant from filing under the UDRP, nor from potentially succeeding on the merits.

Because of this general view toward laches, and the absence of any argument or evidence from the Respondent showing any detrimental reliance on the Complainant's delay, the Panel rejects the Respondent's laches arguments.

The Panel finds that the Respondent has not overcome the Complainant's *prima facie* showing, and that accordingly the Complainant has established this second element under the Policy.

### **C. Registered and Used in Bad Faith**

The Policy requires a complainant to establish that the disputed domain name was registered and is being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a

respondent “[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent’s] website or other online location, by creating a likelihood of confusion with complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [respondent’s] website or location or a product or service on [the respondent’s] website or location”.

The Complainant asserts that the Respondent knew about the Complainant and its ROAD LAW mark because the Complainant’s founders were employed by an entity that was affiliated with the Respondent, before such founders left to form the company that is now the Complainant in 1998. In response to the Procedural Order, the Complainant provided a sworn statement regarding the connection between the Parties. The Complainant detailed how the Parties have been in direct competition with one another, in the same city, since the late 1990s. The Complainant alleges that the principal of the Respondent attended the same trade shows as the Complainant’s principals for several years. The Complainant provided evidence showing the Complainant prominently used the ROAD LAW mark at these trade shows, including on the clothing the Complainant’s principals wore at the trade shows while distributing marketing materials. The Complainant provided a sworn statement that one of its principals interacted with the principals of the Respondent, discussing a radio segment (which used the ROAD LAW moniker) and related advertising. The Complainant also recounts how on at least one occasion, one of the principals of the Respondent personally appeared at the Complainant’s exhibit, where he would have seen a marketing banner with the mark ROAD LAW. The Respondent’s principal likewise submitted a sworn statement in response to the Procedural Order, denying any recollection of the events detailed in the Complainant’s sworn statement, saying at one point he even believed that the Complainant had gone out of business.

Many of the assertions relating to the Respondent’s knowledge of the disputed domain name are from 20 years or more ago. Accordingly, it is not unreasonable to conclude that the Respondent may have no specific recollection of knowledge of the ROAD LAW mark from that time period in the past. (At the same time, the Respondent’s suggestion that he thought the Complainant went out of business is an admission of his awareness of their existence, if not their mark.) Nonetheless, the Panel finds it more likely than not that the Respondent was aware of the Complainant and its ROAD LAW mark when it registered the disputed domain name in 2002. Given the various connections between the Parties—the geographic proximity of the two entities in the same city and state, the similarities in the law practices (both within a specific niche), the assertions of communications and interactions between the Parties, and the fact of the employment by an affiliated entity of the Respondent’s principals—it is hard to explain the Respondent’s decision to register the disputed domain name as not in relation to the Complainant and its rights. The Panel finds this to be bad faith registration.

The Respondent admits that it is using the disputed domain name for commercial purposes. The Panel finds this use of the disputed domain name—which is identical to the Complainant’s mark registered more than 20 years ago and has used extensively in commerce—to be a bad faith effort to seek to trade on the Complainant’s trademark rights. This is bad faith use of the disputed domain name.

Accordingly, for these reasons, the Panel finds that the Complainant has met this third element under the Policy.

#### **D. Reverse Domain Name Hijacking**

Having found in favor of the Complainant, the Panel likewise declines to find that the Complainant engaged in Reverse Domain Name Hijacking.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <roadlaw.com> be transferred to the Complainant.

*/Evan D. Brown/*

**Evan D. Brown**

Presiding Panelist

*/W. Scott Blackmer/*

**W. Scott Blackmer**

Panelist

*/Brian J. Winterfeldt/*

**Brian J. Winterfeldt**

Panelist

Date: July 12, 2023